

REMARKS/ARGUMENTS

Claims 1, 3, 5, 7, 9-13, and 22-39 were examined in the office action mailed March 13, 2006. Applicants acknowledge with appreciation the indicated allowability of claims 7, and 9-13. Applicants respectfully request reconsideration of the remaining claims of this application in view of the foregoing amendments and the following comments.

In the Office Action mailed March 13, 2006, claims 1, 3, 5, and 22-39 were rejected as follows:

- Claims 1, 26, and 30 were rejected under 35 U.S.C. § 102(b), as allegedly anticipated by U.S. Patent Application Publication No. 2001/0030393 to Flannery (the "Flannery application").
- Claims 3, 5, and 27-29 were rejected under 35 U.S.C. § 103(a), as allegedly obvious over the Flannery application in view of U.S. Patent No. 4,974,122 to Shaw (the "Shaw patent").
- Claims 22-25 apparently were rejected as allegedly obvious, but the Office Action failed to associate their rejection with any particular prior art publication(s).¹
- Claims 31-39 were rejected under 35 U.S.C. § 103(a), as allegedly obvious over U.S. Patent No. 5,451,054 to Orenstein (the "Orenstein patent") in view of the Shaw patent.

Applicants respectfully traverse these rejections.

¹ Claims 22 and 23 both depend from allowable dependent claim 7, so the Examiner's apparent obviousness rejection of these two claims makes no sense. Claims 24 and 25 both depend from independent claim 1, and Applicants suspect that the Examiner might have intended to reject these two claims as obvious in view of the Flannery application.

By this Amendment, independent claims 1 and 31 have been amended, to define the invention with greater particularity and thereby to highlight the distinctions of the present invention over the disclosures of the cited references. In addition, allowable claim 7 has been amended to be in independent form and to include all of the features acknowledged by the Examiner to be allowable. Dependent claim 27 has been canceled, without prejudice, and dependent claim 28 has been amended to depend from claim 1 rather than canceled claim 27. Finally, new dependent claim 40 has been added.

Thus, 27 claims are presented for consideration, including independent claim 1 and its dependent claims 3, 5, 11-13, 24-26, and 28-30; independent claim 7 and its dependent claims 22 and 23; independent claim 9 and its dependent claim 10; and independent claim 31 and its dependent claims 32-40. All of these claims are properly allowable.

**I. The § 102(b) Rejection of Claims 1, 26, and 30
Based on the Flannery Application**

As mentioned above, independent claim 1 and dependent claims 26 and 30 were rejected under 35 U.S.C. § 102(b), as allegedly anticipated by the newly cited Flannery application. Applicants respectfully traverse this rejection. The Flannery application fails to disclose a poker table having all of the features of these claims.

The Flannery application discloses a casino game having a playing surface 14 with a betting area 20. The betting area includes a large number of betting spaces 22 stacked in a pyramidal group 24 and a rectangular group 26. Each betting space 22 is formed of a translucent material and is separately illuminated by a light located beneath the playing surface 14. A panel of switches 47 is controllably operated by a croupier 16, to selectively illuminate the individual betting spaces 22. A betting space 22 is withdrawn from the betting field by extinguishing the light beneath it.

Rejected independent claim 1 defines a poker table including the following elements: (1) a tabletop defining a planar playing surface; (2) one or more supports for supporting the tabletop; (3) a planar, translucent light window coplanar with the plane of the playing surface; and (4) a light source configured to project light upwardly through the light window. In addition, by this Amendment, independent claim 1 has now been amended to specify that “the light window is elongated and extends substantially around the periphery of the playing surface.”

In rejecting independent claim 1 based on the Flannery application, the Examiner implicitly took the position that Flannery’s betting spaces 22 correspond to the “light window” element of independent claim 1. These betting spaces are arranged in the *center* of the playing surface 14, and this contrasts with the light window of amended independent claim 1, which is elongated and extends substantially around the periphery of the playing surface. Moreover, the Flannery’s lighting system is configured merely to highlight selected betting spaces and thereby show the progress of the game; it is not configured to provide continuous lighting of the space above the game table.

For these reasons, the Flannery application fails to disclose a poker table incorporating the required light window, and it therefore fails to anticipate amended independent claim 1, or its dependent claims 26 and 30. The rejection of claims 1, 26 and 30, as allegedly anticipated by the Flannery application, therefore, is improper and should be withdrawn.

II. The § 103(a) Rejection of claims 3, 5, 22-25, and 28-29

Claims 3, 5, 22-25, and 28-29 all were rejected under 35 U.S.C. § 103(a). Claims 3, 5, and 28-29 were asserted to be allegedly obvious over the Flannery application in view of the Shaw patent, while claims 22-25 were asserted to be obvious without an

identification of any particular prior art reference(s). Applicants respectfully traverse these rejections, for the reasons set forth below.

A. Dependent Claims 3, 5, 28, and 29

Claims 3, 5, 28, and 29 all were rejected under 35 U.S.C. § 103(a), as allegedly obvious over the Flannery application in view of the Shaw patent. First, it must be noted that these four claims all depend from amended independent claim 1, which defines a poker table incorporating *inter alia* (1) a tabletop defining an opaque, planar playing surface, and (2) a translucent light window coplanar with the playing surface and extending substantially around the periphery of the playing surface. Neither reference discloses such a structure. Moreover, it's not even clear how the disclosures of the two references might be combined to arrive at this feature.

Is the Examiner asserting that a string of Shaw's luminaires should be placed around Flannery's game table, coplanar with the playing surface? Such a wholesale reconstruction of Flannery's game table could not be argued reasonably to have been obvious. Where is the suggestion in the art, first to modify Flannery's game table to include an integral lighting system, and second to do so using a plurality of light sources of a kind designed for use as backlights for LCD arrays, arranged substantially around the periphery of the table's playing surface?

Alternatively, is the Examiner asserting that a single one of Shaw's luminaires should be placed beneath Flannery's game table? That, too, would require a wholesale reconstruction of Flannery's game table. Moreover, such a reconstruction would necessarily cause the luminaire to interfere with the play of Flannery's casino game. Flannery's game includes a betting area 20 having a large number of betting spaces 22 that are separately illuminated by a light located beneath the playing surface 14. A panel of switches 47 is controllably operated by a croupier 16, to selectively illuminate the individual

betting spaces 22. The presence of a single large luminaire like that disclosed in the Shaw patent would interfere with this structure of illuminating individual betting spaces. The Examiner has failed to point out how persons skilled in the art could overcome this incompatibility.

Beyond this identified incompatibility, Applicants note that the Examiner has failed to point out *why* persons skilled in the art would have been motivated to modify Flannery's game table to include a built-in lighting system of the kind being claimed. Any illumination of the space above Flannery's game table is minimal and incidental to its stated function of highlighting individual betting spaces 22 to help gamers track available betting fields. Principal lighting of that space presumably is provided by an *external* lighting system. Thus, the Flannery application lacks any suggestion about integrating a tabletop illumination system into the table, itself. Given the necessary existence of an external tabletop illumination system, where in either patent is there a suggestion to modify the table to include an integrated lighting system? Moreover, why would persons skilled in the art find it necessary to use a special flat plane illumination system like Shaw's luminaire for this limited purpose?

Dependent claims 3, 5, 28, and 29 all depend from amended independent claim 1, defining the invention with even greater specificity and thus further distinguishing over the disclosures of the cited Flannery application and Shaw patent. In particular, claim 3 more particularly defines the table to further include a trough rigidly secured to the underside of the tabletop, for carrying the light source, In commenting on claim 3, the Examiner asserted as follows, at page 3 of the Office Action:

Flannery fails to explicitly teach a trough. Shaw discloses a Compact LCD Luminaire. Shaw teaches a trough for accommodating his light source that is beneath the surface on the outer edge. It would have been obvious to one of ordinary skill in the art at the time the invention was made to

modify Flannery to include a trough to provide uniform lighting.

Applicants agree with the Examiner, that the Flannery application fails to disclose a light trough secured to the underside of the tabletop. However, Applicants respectfully disagree that the Shaw patent makes up for this deficiency. Shaw's LCD luminaire 10 includes a main body 12 having an *integral* flange 14 that defines a space for receiving a fluorescent lamp 18. The patent fails to disclose the required "trough," as a separate and distinct element from a tabletop. *A fortiori*, the patent fails to disclose such a trough being "secured to the underside of [a] tabletop."

Claim 5 more particularly defines the light window to be disposed adjacent to an outer edge of the playing surface. The Examiner has failed to provide any comments as to why this claim is obvious in view of the Flannery application and Shaw patent. Applicants note, however, that neither reference discloses the claimed feature of a "light window . . . disposed adjacent an outer edge of said [opaque] playing surface."

Claims 28 and 29 more particularly define the light window to extend "around the entire periphery of the playing surface" (claim 28), and to have "a generally oval shape" (claim 29). In rejecting these two claims, the Examiner merely asserted as follows, at pages 3-4 of the Office Action:

Shaw fails to teach that his mesa is oval shaped. It would have been obvious to one of ordinary skill in the art to make the table whatever shape desired or expedient. Such would be a design issue. Mere change in shape would present little or no difficulty to one skilled in the art.

Applicants note that these comments fail to address the obviousness of configuring a poker table to include a light window extending "around the *entire* periphery of [an opaque] playing surface. Neither the Flannery application nor the Shaw patent discloses this feature.

Applicants respectfully suggest that the Examiner's position is improperly based on a hindsight reconstruction of the references in light of the disclosure of the instant application. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion to support the combination.

For all of these reasons, the § 103(a) rejection of claims 3, 5, 28, and 29, based on a combination of the Flannery application and the Shaw patent, is improper and should be withdrawn.

B. Dependent Claims 22 and 23

Dependent claims 22-23 depend from allowed independent claim 7. Nonetheless, examiner has rejected these dependent claims under 35 U.S.C. § 103(a), as allegedly obvious over the Flannery application in view of the Shaw patent. Of course, by definition, a proper dependent claim necessarily is narrower than the claim from which it depends. For this reason, the § 103(a) rejection of claims 22 and 23 is improper and should be withdrawn.

C. Dependent Claims 24 and 25

Claims 24 and 25 both depend from amended independent claim 1 and more particularly define the light window to be "formed of milk-colored Plexiglas" (claim 24) or the tabletop to include "a rigid base and a fabric pad overlaying the rigid base" (claim 25). In rejecting these two claims, the Examiner failed to base the rejection on any particular reference(s). Instead, the Examiner merely asserted as follows, at page 4 of the Office Action:

Examiner takes official notice that game tables are known to have rigid plates extending around them with pads covered by various choices of desired materials.

Examiner takes official notice that windows made of glass, Plexiglas and various types of reflective material(s) are known in the art. The use of a milk-colored Plexiglas would be a matter of design choice and would present little or no difficulty to one of ordinary skill in the art.

Applicants disagree. Regardless, claims 24 and 25 both depend from amended independent claim 1, which calls for the light window to be both elongated and to extend substantially around the periphery of the opaque playing surface. The cited references, and in particular the Flannery application nor the Shaw patent, all fail to show or suggest a poker table having this feature.

For these reasons, the rejection of claims 24 and 25 is improper and should be withdrawn.

**III. The § 103(a) Rejection of Claims 31-39
Based on the Orenstein Patent in View of the Shaw Patent**

Claims 31-39 all were rejected under 35 U.S.C. § 103(a), as allegedly obvious over the Orenstein patent in view of the Shaw patent. Applicants respectfully traverse this rejection. These two patents, taken together, fail to show or suggest the invention defined by these claims.

The Orenstein patent discloses a poker table 10 having a plurality of card-receiving stations 12. Each such station includes a transparent window 20 formed in the table, and a card scanning apparatus 24 is located beneath each window, for viewing a face-down playing card placed over it. This enables a viewing audience to view the players' down cards. Orenstein's transparent windows cannot function to illuminate the space above the table, because they are covered by playing cards. In fact, Orenstein's table lacks any built-in system for lighting the space above the table; presumably, the tabletop is illuminated solely by an external lighting system.

The Shaw patent discloses an LCD luminaire 10 configured for use in providing uniform backlighting of an LCD array. The luminaire includes a clear, rectangular main body 12 having a flange 14 extending around its periphery to define a space for receiving a fluorescent lamp 18. Light emitted from the lamp projects into the main body, whereupon it is reflected forwardly through the plate's front surface, to provide uniform backlighting for an overlaying LCD array.

In rejecting independent claim 31, the Examiner asserted as follows, at page 5 of the Office Action:

Orenstein fails to teach a light window that extends around the entire periphery of the playing surface. Shaw teaches that his light source extends around the periphery . . . It would have been obvious to one of ordinary skill in the art at the time the invention was made to include light around the periphery of the modified table of Orenstein for more uniform lighting during game play.

Shaw fails to teach that his mesa is oval shaped. It would have been obvious to one of ordinary skill in the art to make the table whatever shape desired or expedient. Such would be a design issue. Mere change in shape would present little or no difficulty to one skilled in the art.

Orenstein's poker table and Shaw's LCD luminaire are directed to entirely different fields and bear no relationship at all to each other. Orenstein's table lacks any built-in lighting system for illuminating the space above it, and Shaw's LCD luminaire is a structure designed to provide uniform backlighting for an overlaying LCD screen.

The Examiner has failed to point to any teaching or suggestion in the art to modify Orenstein to provide "light around the periphery of the modified table of Orenstein for more uniform lighting during game play." Orenstein's table provides illumination solely for the purpose of illuminating a playing card placed face-down over a viewing window 20.

The table lacks any built-in illumination of the table's playing surface; as mentioned above, presumably that is provided by an *external* lighting system. The Orenstein patent lacks any suggestion about integrating a tabletop illumination system into the table, itself. Why would persons skilled in the art find it necessary to use a special flat plane illumination system like Shaw's luminaire for this limited purpose?

Moreover, the Orenstein and Shaw structures are entirely incompatible with each other. Shaw's LCD luminaire cannot be integrated into Orenstein's table without destroying the operation of Orenstein's card scanning apparatus 24 for scanning any playing card placed over the window 20. Placement of Shaw's luminaire beneath the windows would necessarily interfere physically with the card scanning apparatus. The Examiner has failed to point out how persons skilled in the art could overcome this incompatibility.

The Examiner's assertions regarding combining the disclosures of these two patents reflects classic hindsight—without Applicants' own disclosure to serve as a roadmap, it never would have occurred to the Examiner to have combined their disclosures in the manner contemplated.

Amended independent claim 31 defines a game table including: (1) a tabletop defining an opaque, planar shaped playing surface; (2) one or more supports for the tabletop; (3) an elongated light window extending around a substantial portion of the periphery of the playing surface and past a plurality of player stations; and (4) a light source configured to project light through the light window to the space above the playing surface. In addition, by this Amendment, claim 31 has been amended to delete the requirement that the playing surface have a generally oval shape.

Neither the Orenstein patent nor the Shaw patent discloses a game table including the required *elongated* light window extending *around* a substantial portion of the periphery of an opaque playing surface. The Examiner has failed to address this deficiency.

Shaw's luminaire does, in fact, disclose an elongated *light source* extending around a substantial portion of the periphery of a clear main body. However, an elongated light source is not the same as an elongated light window. Nor is a clear main body the same as an opaque playing surface. Thus, even if Orenstein's poker table were to be modified to include Shaw's elongated light source around its periphery, the so-modified table still would lack the required elongated window extending around a substantial portion of the playing surface's periphery.

Rejected dependent claims 32-39 and new dependent claim 40 all depend from amended independent claim 31. These claims add structural features that further distinguish over the cited references, including the Orenstein patent and the Shaw patents.

For all of these reasons, the § 103(a) rejection of independent claim 31 and its dependent claims 32-39, based on a combination of the Orenstein patent and the Shaw patent, is improper and should be withdrawn.

IV. Conclusion

This application should now be in condition for allowance of claims 1, 3, 5, 7, 9-13, 22-26, and 28-40. Issuance of a notice of allowance is respectfully requested. If the Examiner believes that a further telephone conference with the Applicants' undersigned attorney might expedite the prosecution of this application, she is invited to call at the telephone number indicated below.

Appl. No. 10/617,477
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Any additional fees due in connection with the filing of this Amendment
should be charged to Deposit Account No. 19-1853.

Respectfully submitted,

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